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09/731,968	12/06/2000	Yorihiko Sakai	21778.04800	1405

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EXAMINER

HO, THOMAS Y

ART UNIT PAPER NUMBER

3677

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/731,968

**Applicant(s)**

SAKAI ET AL.

**Examiner**

Thomas Y Ho

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,10-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8, 10-18, 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

Claims 1, 4-8, 10-18, and 20-25 are pending. Claims 2-3, 9, and 19 have been cancelled.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4-6, 8, 12-14, 18, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota US6337712 in view of Enomoto US5974401.**

As to claim 1, Shiota discloses, an information storage system comprising: a server 6 apparatus connected to a network, for storing image data supplied via the above network; and a terminal 15 used by the user to transmit said image data to said server apparatus via said network and read said image data specified according to external operations from said server apparatus via said network, and said information storage system wherein: said server apparatus has storing means for storing said image data supplied via said network in association with specific identification information (file names; col.3, ln.28-40), reading means for reading said image data corresponding to the above identification information from said storing means based on a reading request transmitted from said terminal via said network and said identification information, and transmitting means for transmitting said image data read from said storing means by said reading means to said terminal according to said reading request via said network (col.7, ln.47-58); wherein said storing means of said server apparatus stores ordering data

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(downloading or printing), which is supplied together with said image data from said terminal via said network and created by said external operations by said user based on the above user's desired utilization contents, in association with said identification information as a utilization history; said reading means reads said user's utilization contents (downloaded pictures requested) corresponding to the above identification information from said utilization history stored in said storing means based on said reading request given from said terminal via said network and said identification information; said transmitting means transmits said user's utilization contents read from said utilization history of said storing means by said reading means to said terminal on the above network according to said reading request via said network; said server apparatus creates customer data based on said ordering given from said terminal and performs customer control based on the above customer data (the control can be printing). The difference between the claim and Shiota is the claim recites, and wherein said server apparatus stores a printing reservation list indicating a reception number, a reservation date and time, a printing status, and a delivery status. Enomoto discloses a digital print ordering system similar to that of Shiota. In addition, Enomoto further teaches a server apparatus 13 stores a printing reservation list indicating a reception number, a reservation date and time, a printing status, and a delivery status (col.3, ln.64-67; col.4, ln.20-31). It would have been obvious to one of ordinary skill in the art, having the disclosures of Shiota and Enomoto before him at the time the invention was made, to modify the method of Shiota to include the reservation and delivery steps of Enomoto, to obtain an automated system for print-ordering and delivery. One would have been motivated to make such a combination because the ability to provide home-delivery service (col.4, ln.30-40) and

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access multiple digital printers with different sizes of materials to make different print sizes, (col.4, ln.65-67; col.5, ln.1-10) would have been achieved, as taught by Enomoto.

As to claim 4, Shiota discloses, wherein; said terminal includes printing means 9 for printing an image based on said image data read from said server apparatus according to said external operations via said network.

As to claim 5, Shiota discloses, wherein; said terminal includes recording means (memory) for recording in a recording medium, said image data read from said server apparatus according to said external operations via said network.

As to claim 6, Enomoto teaches, wherein, said server apparatus includes billing processing means for calculating a fee based on said ordering data and performing predetermined billing processing according to the above calculation result (col.4, ln.30-40).

As to claim 8, Shiota discloses, a server apparatus comprising: storing means for storing image data supplied from a terminal via a network in association with specific identification information; reading means for reading said image data corresponding to the above identification information from said storing means based on a reading request given by the user from said terminal via said network and said identification information; and transmitting means for transmitting said image data read from said storing means by said reading means to said terminal on the above network corresponding to said reading request via said network; wherein said storing means stores said user's utilization contents of the above image data during transmission operation on said terminal which is supplied together with said image data from said terminal via said network in association with said identification information as a utilization history; said reading means reads said user's utilization contents corresponding to the above identification

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information from said utilization history stored in said storing means based on said reading request given from said terminal via said network and said identification information; and said transmitting means transmits said user's utilization contents read from said utilization history of said storing means by said reading means to said terminal on the above network according to said reading request via said network. Enomoto teaches, and said storing means also stores a printing reservation list indicating a reception number, a reservation date and time, a printing status, and a delivery status.

As to claim 12, Shiota discloses, wherein; said terminal includes printing means for printing an image based on said image data supplied via said network.

As to claim 13, Shiota discloses, wherein; said terminal includes recording means for recording said image data supplied via said network in a recording medium.

As to claim 14, Shiota discloses, wherein; said transmitting means transmits via said network, said image data read by said reading means from said storing means to said terminal specified by said user through said reading request given via said network.

As to claim 18, Shiota discloses, an information control method comprising: a first step of storing image data supplied from a terminal via a network in association with specific identification information; a second step of reading said image data corresponding to the above identification information based on a reading request given by the user from said terminal via said network and said identification information; and a third step of transmitting said read image data to said terminal on the above network according to said reading request via said network, wherein in said first step said user's utilization contents of the above image data during a transmission operation on the above terminal supplied together with said image data from said

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terminal via said network are stored in association with said identification information as a utilization history; in said second step, said user's utilization contents corresponding to the above identification information are read from said stored utilization history based on said reading request given from said terminal via said network and said identification information, and in said third step said user's utilization contents read from said utilization history transmitted to said terminal on the above network according to said reading request via said network. Enomoto teaches, storing a printing reservation list indicating a reception number a reservation date and time, a printing status and a delivery status.

As to claim 22, Shiota discloses, characterized in that; in said third step, said read image data is transmitted via said network to said terminal specified by said user by said reading request given via said network.

As to claim 25, Enomoto teaches, characterized by; including a fourth step of calculating a fee based on said user's utilization contents and performing predetermined billing processing according to the above calculation result.

**Claims 7, 15-16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota US6337712 in view of Enomoto US5974401, and further in view of Schelling US5706097.**

As to claim 7, Shiota discloses, wherein, said server apparatus stores said image data, reads said image data from said storing means based on a reading request transmitted from said terminal via said network and transmits said image data read from said storing means by said reading means to said terminal according to said reading request via said network. The difference between the claim and Shiota is the claim recites, also combined image data.

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Schelling discloses a digital method of displaying photographs similar to that of Shiota. In addition, Schelling further teaches transmitting and displaying combined image data (digital index prints). It would have been obvious to one of ordinary skill in the art, having the disclosures of Shiota and Schelling before him at the time the invention was made, to modify the apparatus of Shiota to also transmit/display combined image data, as in Schelling, to obtain digital index prints. One would have been motivated to make such a combination because the ability to visually compare the subject matter of several images would have been achieved, as taught by Schelling (col.2, ln.1-15).

As to claim 15, Schelling teaches, wherein; said storing means stores not only said image data but also combined image data to combine an image based on said image data.

As to claim 16, Shiota discloses, wherein: said reading means reads said image data from said storing means according to said reading request; and said transmitting means transmits said image data read from said storing means by said reading means to said terminal according to said reading request. Schelling teaches combined image data.

As to claim 23, Shiota discloses, characterized in that; in said first step, said image data are stored. Schelling teaches combined image data based on image data are stored.

As to claim 24, Shiota discloses, characterized in that: in said second step, said image data is read according to said reading request; and in said third step, said read image data is transmitted to said terminal according to said reading request. Schelling teaches combined image data.



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**Claims 10-11, 17, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota US6337712 in view of Enomoto US5974401, and further in view of Barraclough US6301607.**

As to claim 10, the difference between the claim and Shiota is the claim recites, wherein; said user's utilization contents includes at least one of personal information of said user, preference information and billing information. Barraclough discloses a method of sharing and displaying images over a network similar to that of Shiota. In addition, Barraclough further teaches said user's utilization contents includes at least one of personal information of said user, preference information and billing information (col.2, ln.60-67; col.3, ln.1-5). It would have been obvious to one of ordinary skill in the art, having the disclosures of Shiota and Barraclough before him at the time the invention was made, to modify the contents of the images in Shiota to further include personal and/or billing information, as in Barraclough, to obtain imbedded information. One would have been motivated to make such a combination because the ability to provide an easy way to return communication to a sender would have been achieved, as taught by Barraclough (col.2, ln.60-67).

As to claim 11, Barraclough teaches, wherein; said personal information of said user includes at least one of said user's name, address, phone number and e-mail address.

As to claim 17, Enomoto teaches, characterized by, including billing processing means for calculating a fee based on said user's utilization contents and performing predetermined billing processing according to the above calculation result (col.4, ln.30-40; already detailed in a previous rejection).

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As to claim 20, Barracclough teaches, wherein; said user's utilization contents include at least one of personal information of said user, preference information and billing information.

As to claim 21, Barracclough teaches, wherein; said personal information of said user includes at least one of said user's name, address, phone number and e-mail address.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4-8, 10-18, and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

clubphoto.com from dates prior to 12/07/1999, retrieved from archive.org.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH



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